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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,143	12/10/2001	Jeong-Goo Yoon	2336-086	9603

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EXAMINER

FOURSON III, GEORGE R

ART UNIT PAPER NUMBER

2823

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/006,143		YOON ET AL.	
	Examiner		Art Unit	
	George Fourson		2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 14 and 17 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 15, 16 and 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20011210</u> . | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. ***.

Claim 3 contains the trademark/trade name Aqua. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a wax composition and, accordingly, the identification/description is indefinite.

Claims 1,2,4-11,14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigg et al.

The rejection is maintained as stated in the paper mailed 10/7/03 and as follows.

Grigg does not disclose heating the chuck on a hot plate to the recited temperature. It would have been within the scope of one of ordinary skill in the art to heat the chuck to the recited temperature prior to

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the disclosed process of grinding/lapping followed by cooling and performing the recited process of attaching the wafer etc. because such a step would not have been expected to have a material effect on the disclosed process. The claim does not require a temporal relationship with regard to the heating step. Use of a heated object to heat the chuck would have been a normal expedient, the use of heated objects to heat other objects having been known at the time of applicant's invention.

One of ordinary skill in the art would have been led to the recited temperature of claim 4 through routine optimization depending on the melting point of the wax used to mount the UV coated wafer.

Applicant argues that Grigg does not disclose lapping. However, the reference discloses "the process can also be extended to include chemical mechanical polishing" (col.2, lines 35-37).

Applicant argues that Grigg does not disclose use of a tape and a binder. The rejection is predicated on this fact as stated in the office action mailed 10/7/03. Reasoning has been provided to employ both tape and wax with a reasonable expectation of success that the adhesive wax would serve to adhere the tape covered wafer to the chuck. Furthermore, claim 14 indicates that claim 1 is open to removal of the tape prior to mounting with wax because the claim is presumed to be further limiting of the subject matter of claim 1.


Claims 12,13,15,16 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956 until 2/4/04. See MPEP 203.08.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner George Fourson whose telephone number is (571)272-1860. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri, can be reached on (571)272-1855. The fax number for this group is (571)273-0224 and the customer service number for group 2800 is 571-272-2800. Updates can be found at <http://www.uspto.gov/web/info/2800.htm>.


George Fourson
Primary Examiner
Art Unit 2823

GFourson
April 1, 2004